

Remarks

The non-final Office Action dated September 9, 2008 indicated that claims 7-12 stand rejected under 35 U.S. C. § 103(a) over Ricketson *et al.* (U.S. Patent No. 5,307,978) in view of Sabyeying (U.S. Patent No. 6,062,459). Applicant traverses the rejection.

In light of the appreciated allowance of claims 1-6 and/or Applicant's above-presented amendments, the main issue at hand is the patentability of claims 7-12. While the prior art rejection is based on an erroneous interpretation of the case law and the related relied-upon section of the MPEP (§ 2114), this rejection should be moot because the asserted teachings of the prior art do not correspond to the claimed invention – as acknowledged in the Office Action. Applicant submits that these amendments are merely clarifying, have been made to facilitate prosecution and are not necessary to overcome the rejections (*e.g.*, for failing to show correspondence). Without changing the scope of the claim under the law (as discussed below), Applicant's amendment adds the word "configured" so as to present the same claim clauses in terms "structural" differences that should be more clearly recognizable to the Examiner. Accordingly, the rejection must be withdrawn under either view of the "structural" claim language at issue. In the discussion set forth below, Applicant presents its positions to reserve its right to subsequently prosecute the originally-claimed invention and to avoid the appearance of acquiescence to the rejections or averments in this Office Action.

The Office Action acknowledges that the Ricketson reference does not teach that the cited components are configured as in Applicant's claims but rather are "capable of" being so configured. Relying on MPEP § 2114, the Examiner's erroneous position is that the "capable of" argument is sufficient because "claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function" and Applicant's claims include certain functional language that are not afforded patentable weight. See Office Action at p.3. This position is flawed because under MPEP § 2114 and long-standing law, such language is deemed functional and not afforded patentable weight when it is found in the preamble (*i.e.*, before the "comprising:" clause). For example, MPEP § 2114 cites *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) for the proposition that

The preamble of claim 1 recited that the apparatus was ‘for mixing flowing developer material’ and the body of the claim recited ‘means for mixing ..., said mixing means being stationary and completely submerged in the developer material’. The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.

According to a recent decision by the USPTO Board of Appeals, the “*Gulack* provides the appropriate test for determining whether limitations defining descriptive material should be given patentable weight” and the test is whether the noted functional aspects are related to the clear-cut structure recited in the apparatus claim. See *Ex parte* ROGER A. HANSEN, Appeal 2007-3424 (May 13, 2008), citing *In re Max Gulack*, 703 F.2d 1381 (Fed. Cir. 1983). In *Gulack*, the Court explained that,

The board cited no authority in analyzing the relevance of the lack of a functional relationship, or of the status of the printed matter as non-statutory subject matter, to its decision not to accord the printed matter patentable weight. Because of the possible ambiguity of the board's articulation of its holding, we feel compelled to clarify the distinction. Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole. If the board meant to disregard that basic principle of claim interpretation, we must reverse the rejection as a matter of law. ... [B]ecause we find that the digits of *Gulack's* invention are functionally related to the band, and because *Wittcoff* fails to disclose or suggest the subject matter recited in the appealed claims, considered as a whole, we reverse.

For the instant rejection, the Office Action provides no discussion regarding the relevance of the lack of a functional relationship to its decision not to accord the noted claim terms as having patentable weight. Rather, the Office Action provides a mere conclusion plus a cite to MPEP 2114, whereas the claimed invention clearly relates the so-called functional language to the noted structure. For instance, the claimed movable second clamp is structurally (configured) for “clamping the leads of n adjacent lead frames of a second row of lead frames that is adjacent and parallel to the first row as seen in the index direction, the second clamp being movable in the index direction relative to the wirebonding frame”. Because these aspects are related (a clamp arranged for

clamping as such), the noted claim terms must be accorded as having patentable weight – according to the test as explained by the Court of Appeals for the Federal Circuit and the USPTO Board of Appeals and Interferences.

Applicant's view in this regard is consistent with the long-standing practice of the USPTO under the patent laws regarding functional aspects which further characterize or define structure. Consistent with this long-standing practice by the USPTO, many devices (including, for example, clamps and circuits) represent a physical structure that can be and oftentimes are defined in terms of so-called functional limitations. See, e.g., *In re Alappat*, 33 F.3d 1526, 1544 (Fed. Cir. 1994) ("[T]he term 'circuit' with an appropriate identifier such as 'interface,' 'programming' and 'logic,' certainly identifies some structural meaning to one of ordinary skill in the art."); *Apex Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1373 (Fed. Cir. 2003) ("In two of our prior cases we concluded that the term 'circuit,' combined with a description of the function of the circuit, connoted sufficient structure to one of ordinary skill in the art to avoid 112 P6 treatment . . . This description of the operation of the circuit is sufficient to avoid 112 P6.").

Notwithstanding the above discussion, Applicant has amended the language of the rejected claims to more overtly characterize and integrate the functional and structural limitations, which should be apparent without the amendments.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063 (or the undersigned).

Please direct all correspondence to:

Corporate Patent Counsel
NXP Intellectual Property & Standards
1109 McKay Drive; Mail Stop SJ41
San Jose, CA 95131

CUSTOMER NO. 65913

By: 

Name: Robert J. Crawford
Reg. No.: 32,122
651-686-6633
(NXPS.406PA)